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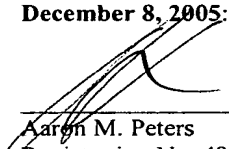
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : BEAULIEU, Nicole
Ser. No. : 10/073,598
Filed : February 11, 2002
Title : Automated Selection of Video
Gaming Options
Art Unit : 3714
Examiner : Mosser, Robert E.

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) P.O. Box 1450
) Alexandria, VA 22313-1450

) **December 8, 2005:**

) 
) Aaron M. Peters
) Registration No. 48,801
) Attorney for Applicant

REVISED APPEAL BRIEF TRANSMITTAL

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Sir:

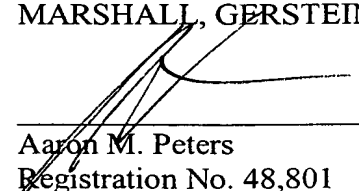
The Response to Notification of Non-Compliant Appeal Brief and the revised appeal brief for the appeal taken to the Board of Patent Appeals and Interferences in connection with the present application is submitted herewith. The fees required for the large-entity fee for filing the appeal brief under 37 C.F.R. §41.20(b)(2) were submitted with the previous appeal brief filing dated March 16, 2005 and, therefore, no fees are believed due at this time.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

December 8, 2005

By:


Aaron M. Peters
Registration No. 48,801
Attorney for Applicant
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
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PATENT

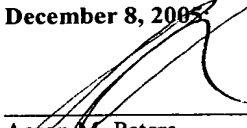
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) Attorney for Applicant

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the "Notification of Non-Compliant Appeal Brief" having a mail date of November 8, 2005, setting a one-month deadline for reply.

On December 6, 2005, Applicants' attorney, Aaron M. Peters (Reg. No. 48,801) conducted a telephonic interview with Examiner Robert E. Mosser in which the Notification of Non-Compliant Appeal Brief and 37 C.F.R. § 41.37(c)(1)(v) were discussed. Applicant gratefully appreciates the Examiner Mosser's comments presented during the interview. Upon reviewing the rule, reviewing MPEP 1205, discussing the rule with other examiners, reviewing the Federal Register, vol. 69, No. 155 (8-12-2004) and reviewing the training presentation entitled "Final Rule Making on Practice Before the Board of Patent Appeals and Interferences (BPAI), Examiner Mosser indicated during the interview that 37 C.F.R. § 41.37 was not specific regarding the inclusion of dependent claims in the Summary of Claimed Subject Matter. In particular, 37 C.F.R. § 41.37 is unclear as to whether dependent claims argued separately in Argument must be included in the Summary of Claimed Subject Matter when they do not include means plus function language under 35 U.S.C. § 112, sixth

paragraph. Examiner Mosser further indicated that while he was unaware of any instance where the BPAI notified an appellant of noncompliance for not including dependent claims in the Summary of Claimed Subject Matter when they do not include language under 35 U.S.C. § 112, sixth paragraph, Examiner Mosser issued the Notification of Non-Compliant Appeal Brief primarily as a precautionary measure in light of the lack of clarity regarding 37 C.F.R. § 41.37(c)(1)(v) and to avoid a notice of noncompliance from the BPAI.

Accordingly, Applicant respectfully submits that the Revised Appeal Brief filed on July 14, 2005, and the Second Revised Appeal Brief submitted herewith, fully comply with 37 C.F.R. § 41.37. In particular, Applicant respectfully submits that 37 C.F.R. § 41.37(c)(1)(v) only requires that the Summary of Claimed Subject Matter include dependent claims argued separately under the provisions of 37 C.F.R. § 41.37(c)(1)(vii) when the dependent claims include means plus function or step plus function language as permitted by 35 U.S.C. § 112, sixth paragraph. The first sentence of 37 C.F.R. § 41.37(c)(1)(v) reads:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

This sentence clearly pertains only to “each of the independent claims involved in the appeal,” and does not pertain to dependent claims. The second sentence of 37 C.F.R. § 41.37(c)(1)(v) reads:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

This second sentence pertains to “each dependent claim argued separately under the provisions of paragraph (c)(1)(vii)” in addition to “each independent claim involved in the appeal.” However, the second sentence pertains only to those claims that recite means plus function or step plus function language as permitted by 35 U.S.C. § 112, sixth paragraph.

In particular, the second sentence states that “for each dependent claim argued separately ..., every means plus function and step plus function as permitted by 35 U.S.C. § 112, sixth paragraph must be identified”. The second sentence continues: “the structure,

material, or acts described in the specification as corresponding to each claimed function must be set forth ...” Notably, there is no punctuation, such as a comma, period or semicolon, between these first and second phrases, thereby indicating they are part of the same thought. In other words, the second sentence requires that every means plus function or step plus function must be identified, and for each claimed function recited in means plus function or step plus function language, the corresponding structure, material, or acts described in the specification must be set forth with reference to the specification and to the drawings. However, if none of the claims include means plus function or step plus function language, then such a requirement is not applicable. Accordingly, no part of the second sentence pertains to dependent claims that do not recite means plus function or step plus function language as permitted by 35 U.S.C. § 112, sixth paragraph.

None of the dependent claims 2-11, 13-22, 24-32, 34-40 or 42-45, which are argued in the Argument section of Applicant’s Appeal Brief, includes any means plus function or step plus function language as permitted by 35 U.S.C. § 112, sixth paragraph. Accordingly, identification of means plus function and step plus function, and reference to the specification and to the drawings for structure, material or acts corresponding to each claimed function is not applicable to the enclosed Revised Appeal Brief, and 37 C.F.R. § 41.37(c)(1)(v) is not relevant to the dependent claims argued in the Argument Section of Applicant’s Appeal Brief.

Reconsideration and withdrawal of the Notification of Non-Compliant Appeal Brief in view of the remarks above is respectfully requested. In light of the foregoing, the prompt consideration of the merits of Applicant's Appeal Brief is respectfully requested. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

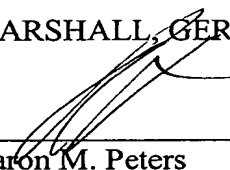
Applicant believes no additional fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. §§ 1.16 or 1.17 to Deposit Account No. 13-2855.

Respectfully submitted,

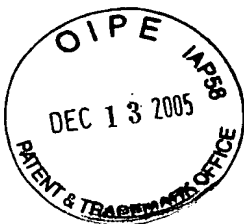
MARSHALL, GERSTEIN & BORUN LLP

December 8, 2005

By:



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233 South Wacker Drive
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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : BEAULIEU, Nicole

Ser. No. : 10/073,598

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Title : Automated Selection of Video
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Art Unit : 3714

Examiner : Mosser, Robert E.

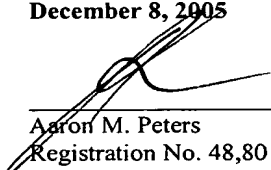
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) Commissioner for Patents

) P.O. Box 1450

) Alexandria, VA 22313-1450, on this date:

) **December 8, 2005**

) 
) _____
) Aaron M. Peters
) Registration No. 48,801
) Attorney for Applicant

REVISED APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the "Notification of Non-Compliant Appeal Brief" having a mail date of November 8, 2005, setting a one-month deadline for reply. The fees required under 37 CFR 41.20(b)(2) were submitted with the previous Appeal Brief filing, and therefore no fees are believed due at this time. Consideration of the merits of Applicant's Appeal Brief is respectfully requested.

(I) REAL PARTY IN INTEREST

The real party in interest is IGT, the assignee of rights in the present application via an assignment recorded in the Patent Office at Reel 012789, Frame 0108.

(II) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(III) STATUS OF CLAIMS

Claims 1-45 are pending and have been rejected. Applicant appeals the rejection of claims 1-45. The claims are reproduced in the Appendix set forth below.

(IV) STATUS OF AMENDMENTS

No amendment of the claims was made subsequent to the final rejection.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims are directed to a gaming apparatus and method which enables a person to request the gaming apparatus to make an automated selection from among a plurality of user-selectable options. The claimed subject matter is generally disclosed at page 27, lines 5-24 of the specification and Fig. 18. More specific support, as well as reference numerals for exemplary structure corresponding to claimed subject matter, is provided below.

Independent claims 1, 12 and 23 are directed to a gaming apparatus. Referring to Figs. 2 and 3, the gaming apparatus 20 comprises a display unit 70 capable of generating video images (page 8, line 29 to page 9, line 2), a value input device 52, 54, 56, 58 (page 7, line 30 to page 8, line 5), and a controller 100 operatively coupled to the display unit 70 and the value input device 52, 54, 56, 58 (page 11, lines 10-22). The controller 100 includes a processor 104 and a memory 102, 106 operatively coupled to the processor 104 (page 10, line 29 to page 11, line 9). Referring to Figs. 8, 9, 11 and 13, the controller 100 is programmed to allow a person to make a wager on an occurrence of a wagering game. *See also* page 9, line 25 to page 10, line 7; page 16, lines 11-16; page 19, lines 6-10; page 21, lines 18-24; and page 23, lines 15-18. Referring to Fig. 18 and the paragraph starting on line 5 of page 27, the controller 100 is programmed to receive data relating to a request from the person made during the occurrence of the wagering game for the controller 100 to make an automated selection from among a plurality of user-selectable options presented to the person. *See also* page 10, lines 9-11; page 16, lines 22-26; page 19, lines 15-18; page 21, lines 13-15; page 23, lines 21-22; page 25 line 31 to page 26 line 5; Figs. 2A, 8, 9, 11, 13 and 14. Also referring to Fig. 18 and the paragraph starting on line 5 of page 27, the controller 100 is programmed to make an automated selection from among the plurality of user-selectable options in response to the request. *See also* page 10, lines 9-11; page 16, line 27 to page 17, line 14; page 19, lines 18-29; page 21, lines 13-15; page 23, lines 21-22; page 26, lines 15-18; Figs. 2A, 8, 9, 11, 13 and 14. Referring to Figs. 6, 7, 10, 12 and 15-17, the controller 100 is programmed to cause a video image to be generated on the display unit 70. *See also* page 15, line 22 to page 16, line 6; page 18, line 18 to page 19, line 4; page 20, line 22 to page 21, line 5; and page 22, line 20 to page 23, line 4. Referring to Figs. 8, 9, 11, 13 and 14, the controller 100 is programmed to determine a value payout associated with an outcome of the game. *See also* page 18, lines 3-4; page 20, lines 14-15; page 22, lines 10-12; page 24, line 3, page 26, lines 27-29.

Independent claim 1 also recites that the video image represents a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo. The video image comprises an image of at least five playing cards if the game comprises video poker. *See* page 15, lines 24-25; Fig. 6. The video image comprises an image of a plurality of simulated slot machine reels if the game comprises video slots. *See* page 20, lines 23-25; Fig. 10. The video image comprises an image of a plurality of playing cards if the game comprises video blackjack. *See* page 18, lines 20-23; Fig. 7. The video image comprises an image of a bingo grid if the game comprises video bingo. *See* page 22, lines 22-23; Fig. 12.

Independent claim 12 also recites that the video image represents a game other than video keno. *See* Figs. 6-17. The controller is programmed to determine, after the video image has been displayed, a value payout associated with an outcome of the game represented by the video image. *See* page 18, lines 3-4; page 20, lines 14-15; page 22, lines 10-12; page 24, line 3, page 26, lines 27-29.

Independent claim 23 also recites that the controller is programmed to allow a person to make a payline selection. *See* page 21, lines 10-13, Fig. 11. The video image comprises a plurality of simulated slot machine reels of a slots game, each of the slot machine reels having a plurality of slot machine symbols. *See* page 20, lines 23-25; Fig. 10. The controller is programmed to determine a value payout associated with an outcome of the slots game and to determine the value payout based on at least one of a configuration of the slot machine symbols and display of a particular slot machine symbol. *See* page 22, lines 3-12.

Independent claim 33 is directed to a gaming method. Referring to Figs. 6, 7, 10, 12 and 15-17, the method includes causing a video image to be generated. *See also* page 15, line 22 to page 16, line 6; page 18, line 18 to page 19, line 4; page 20, line 22 to page 21, line 5; and page 22, line 20 to page 23, line 4. The video image represents a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo. The video image comprises an image of at least five playing cards if the game comprises video poker. *See* page 15, lines 24-25; Fig. 6. The video image comprises an image of a plurality of simulated slot machine reels if the game comprises video slots. *See* page 20, lines 23-25; Fig. 10. The video image comprises an image of a plurality of playing cards if the game comprises video blackjack. *See* page 18, lines 20-23; Fig. 7. The video image comprises an image of a bingo grid if the game comprises video bingo. *See* page 22, lines 22-23; Fig. 12. Referring to Figs. 8, 9, 11 and 13, the method additionally includes allowing a person to make a wager on an occurrence of a wagering game. *See also* page 9, line 25 to page 10, line

7; page 16, lines 11-16; page 19, lines 6-10; page 21, lines 18-24; and page 23, lines 15-18. Referring to Fig. 18 and the paragraph starting on line 5 of page 27, the method also includes receiving data relating to a request from the person made during the occurrence of the wagering game for the controller 100 to make an automated selection from among a plurality of user-selectable options presented to the person. *See also* page 10, lines 9-11; page 16, lines 22-26; page 19, lines 15-18; page 21, lines 13-15; page 23, lines 21-22; page 25 line 31 to page 26 line 5; Figs. 2A, 8, 9, 11, 13 and 14. Also referring to Fig. 18 and the paragraph starting on line 5 of page 27, the method performs an automatic selection from among the plurality of user-selectable options in response to the request. *See also* page 10, lines 9-11; page 16, line 27 to page 17, line 14; page 19, lines 18-29; page 21, lines 13-15; page 23, lines 21-22; page 26, lines 15-18; Figs. 2A, 8, 9, 11, 13 and 14. Referring to Figs. 8, 9, 11, 13 and 14, the method determines a value payout associated with an outcome of the game. *See also* page 18, lines 3-4; page 20, lines 14-15; page 22, lines 10-12; page 24, line 3, page 26, lines 27-29.

Independent claim 41 is directed to a memory having a computer program stored therein, the computer program being capable of being used in connection with a gaming apparatus. Referring to Figs. 3, 8, 9, 11 and 13, the memory 102, 106 includes a first memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus 20 to allow a person to make a wager on an occurrence of a wagering game. *See also* page 9, line 25 to page 10, line 7; page 16, lines 11-16; page 19, lines 6-10; page 21, lines 18-24; and page 23, lines 15-18. Referring to Figs. 6, 7, 10, 12 and 15-17, the memory 102, 106 includes a second memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus 20 to cause a video image to be generated on a display unit 70, the video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots, and video bingo. *See also* page 15, line 22 to page 16, line 6; page 18, line 18 to page 19, line 4; page 20, line 22 to page 21, line 5; and page 22, line 20 to page 23, line 4. The video image comprises an image of at least five playing cards if the game comprises video poker. *See* page 15, lines 24-25; Fig. 6. The video image comprises an image of a plurality of simulated slot machine reels if the game comprises video slots. *See* page 20, lines 23-25; Fig. 10. The video image comprises an image of a plurality of playing cards if the game comprises video blackjack. *See* page 18, lines 20-23; Fig. 7. The video image comprises an image of a bingo grid if the game comprises video bingo. *See* page 22, lines 22-23; Fig. 12. Referring to Fig. 18 and the paragraph starting on line 5 of page 27, the memory 102, 106 also includes a third memory portion physically configured in accordance with computer

program instructions that would cause the gaming apparatus 20 to receive data relating to a request from the person made during the occurrence of the wagering game for the controller 100 to make an automated selection from among a plurality of user-selectable options presented to the person. *See also* page 10, lines 9-11; page 16, lines 22-26; page 19, lines 15-18; page 21, lines 13-15; page 23, lines 21-22; page 25 line 31 to page 26 line 5; Figs. 2A, 8, 9, 11, 13 and 14. Also referring to Fig. 18 and the paragraph starting on line 5 of page 27, the memory 102, 106 includes a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus 20 to perform an automated selection from among the plurality of user-selectable options in response to the request. *See also* page 10, lines 9-11; page 16, line 27 to page 17, line 14; page 19, lines 18-29; page 21, lines 13-15; page 23, lines 21-22; page 26, lines 15-18; Figs. 2A, 8, 9, 11, 13 and 14. Referring to Figs. 8, 9, 11, 13 and 14, the memory 102, 106 includes a fifth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus 20 to determine a value payout associated with an outcome of the game. *See also* page 18, lines 3-4; page 20, lines 14-15; page 22, lines 10-12; page 24, line 3, page 26, lines 27-29.

None of independent claims 1, 12, 23, 33 or 41 and none of dependent claims 2-11, 13-22, 24-32, 34-40 or 42-45, which are argued in the Argument section below, includes any means plus function or step plus function language as permitted by 35 U.S.C. §112, sixth paragraph. Accordingly, identification of means plus function and step plus function, and reference to the specification and to the drawings of the structure, material or acts corresponding to each claimed function is not applicable to this Summary of Claimed Subject Matter and is not required under 37 C.F.R. §41.37(c)(1)(v).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Rejection of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43 and 45 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,093,102 to Bennett.**
- B. Rejection of claims 4, 15, 26, 36 and 44 under 35 U.S.C. §103 as being unpatentable over Bennett in view of U.S. Patent No. 6,231,442 to Mayeroff.**
- C. Rejection of claims 5, 16, 27, 37 and 42 under 35 U.S.C. §103 as being unpatentable over Bennett in view of U.S. Patent No. 6,261,178 to Bennett.**

- D. Rejection of claims 10, 11, 21, 22, 31 and 32 under 35 U.S.C. §103 as being unpatentable over Bennett in view of U.S. Patent No. 6,001,016 to Walker et al.**

(VII) ARGUMENT

A. The Rejection of Claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43 and 45 under 35 U.S.C. §102(b) As Anticipated by Bennett Is Not Proper

It is respectfully submitted that a *prima facie* case of anticipation of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43 and 45 has not been made. The following groups of claims are argued separately below: 1) Claims 1, 12 and 23; 2) Claim 33; 3) Claim 41; 4) Claims 2, 3 and 6-9; 5) Claims 13, 14 and 17-20; 6) Claims 24, 25 and 28-30; 7) Claims 34, 35 and 38-40; and 8) Claims 43 and 45.

1. A *Prima Facie* Case of Anticipation of Claims 1, 12 and 23 Has Not Been Made.

Claim 1 is directed to a gaming apparatus which includes, *inter alia*:

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

As indicated above, claim 1 is directed to a gaming apparatus that includes a controller programmed to receive data relating to a request from a person. The request is for the controller to make an automated selection from among a plurality of user-selectable options presented to the player. In response to the request, the controller is programmed to make an automated selection from among the plurality of user-selectable options.

In the final Office Action, claim 1 was rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,093,102 to Bennett. In support of the rejection, the final Office Action states that Bennett discloses “a controller selecting a gaming option automatically from a plurality of user-selectable options if the user requests the controller to do so through not selecting an option (Col. 4:30-33)”. (Office Action dated 9/30/04, pp. 2-3).

Specifically, the cited portion of Bennett reads:

“In the embodiment of FIG. 2, the selection would default to the centre line position in the event that no symbol was selected in a particular column.”

It is respectfully submitted that this excerpt of Bennett does not disclose the claimed features as noted above because the selection is not made in response to a request made by a person as recited in Claim 1.

In response to the applicant's previous arguments that Bennett does not anticipate the claims, the final Office action states the following on page 7:

“... the choice of a player not to select an option may be well understood as the player requesting the automatic selection. The heart of the issue is the fact that both systems provide an automated selection based on the actions (and equivalent lack of action) by the user, hence providing equivalent function as so claimed.”

The final Office Action implicitly admits that Bennett does not disclose receiving data relating to a request by stating that Bennett discloses a controller selecting a gaming option based on a user not selecting an option. The final Office action goes on to reason that action is equivalent to lack of action. In other words, the final Office Action interprets the gaming machine of Bennett as responsive to a lack of action, whereas the gaming apparatus of claim 1 is responsive to action. As a result, the final Office Action implicitly admits that Bennett discloses a feature directly opposite that of the gaming apparatus recited in claim 1.

It is clear from the language quoted above in Bennett, and from the final Office Action's admission, that Bennett makes a default selection in the absence of receiving data relating to a request by a person. However, claim 1 recites “said controller being programmed to receive data relating to a request from a user” and “said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request.” Since Bennett discloses defaulting to a center line position in the absence of a selection, it necessarily does not disclose receiving data relating to a request and making an automated selection from among user-selectable options, as the controller of claim 1 is programmed to do.

It is further submitted that the final Office Action has not made a *prima facie* case of anticipation because the final Office Action uses an erroneous standard for determining anticipation. Instead of pointing out where Bennett discloses receiving data relating to a request by a person for a controller to automatically select a user-selectable option, the final Office Action concludes that an action by the user is equivalent to a lack of action by the user as long as the resulting function is the same. In effect, the final Office action attempts to introduce “equivalency of function” as a new standard for anticipation. However, equivalent function is not the standard for anticipation.

In order for a claim to be anticipated under § 102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. See, for example, C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998)("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device")(emphasis added); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...")(emphasis added).

In order to find that a prior art patent "discloses" a feature, that feature must be disclosed either expressly or inherently. The standard for inherency is strict. Section 2112 of the M.P.E.P. sets forth the standard for inherency as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). >"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (underlining original).

Finally, during prosecution a claim is given its broadest reasonable interpretation as required by the M.P.E.P. See Section 2111 of the M.P.E.P., which states:

"During patent examination, the pending claims must be 'given *>their< broadest reasonable interpretation consistent with the specification.' >In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).<"

It is respectfully submitted that it is not proper to simply ignore plain recitations in a claim, under the guise of applying the broadest reasonable interpretation.

In view of the forgoing, it is respectfully submitted that claim 1 is not anticipated by Bennett and that the rejection is erroneous.

Independent apparatus claims 12 and 23 each contain language that is identical to the relevant recitations of claim 1. Therefore, it is also respectfully submitted that claims 12 and 23 are not anticipated by Bennett.

2. A Prima Facie Case of Anticipation of Claim 33 Has Not Been Made.

Independent claim 33 is directed to a gaming method which includes, *inter alia*:

receiving data relating to a request from said person made during said occurrence of said wagering game to make an automated selection from among a plurality of user-selectable options presented to said person,

performing an automatic selection from among said a plurality of user-selectable options presented to a person in response to said request;

It is respectfully submitted that claim 33 is not anticipated for the same reasons as set forth above for claim 1.

3. A Prima Facie Case of Anticipation of Claim 41 Has Not Been Made.

Independent claim 41 is directed to a memory having a computer program capable of being used in connection with a gaming apparatus which includes, *inter alia*:

a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

a fourth third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among said a plurality of user-selectable options presented to said person in response to said request;

It is respectfully submitted that claim 41 is not anticipated for the same reasons as set forth above for claim 1.

4. A Prima Facie Case of Anticipation of Claims 2, 3 and 6-9 Has Not Been Made

Claims 2, 3 and 6-9 depend from claim 1. It is respectfully submitted that claims 2, 3 and 6-9 are not anticipated for the same reasons as set forth above for claim 1.

**5. A Prima Facie Case of Anticipation of Claims 13, 14 and 17-20
Has Not Been Made**

Claims 13, 14 and 17-20 depend from claim 12. It is respectfully submitted that claims 13, 14 and 17-20 are not anticipated for the same reasons as set forth above for claim 12.

**6. A Prima Facie Case of Anticipation of Claims 24, 25 and 28-30
Has Not Been Made**

Claims 24, 25 and 28-30 depend from claim 23. It is respectfully submitted that claims 24, 25 and 28-30 are not anticipated for the same reasons as set forth above for claim 23.

**7. A Prima Facie Case of Anticipation of Claims 34, 35 and 38-40
Has Not Been Made**

Claims 34, 35 and 38-40 depend from claim 33. It is respectfully submitted that claims 34, 35 and 38-40 are not anticipated for the same reasons as set forth above for claim 33.

**8. A Prima Facie Case of Anticipation of Claims 43 and 45 Has Not
Been Made**

Claims 43 and 45 depend from claim 41. It is respectfully submitted that claims 43 and 45 are not anticipated for the same reasons as set forth above for claim 41.

**B. The Rejection Of Claims 4, 15, 26, 36 And 44 Under 35 U.S.C. §103 As
Being Unpatentable Over Bennett In View Of Mayeroff Is Not Proper.**

The rejection of claims 4, 15, 26, 36 and 44 as being unpatentable over Bennett in view of U.S. Patent No. 6,231,442 to Mayeroff (hereinafter "Mayeroff") is not proper because the final Office Action fails to establish a *prima facie* case of obviousness.

Claims 4, 15, 26, 36 and 44, which depend from claims 1, 12, 23, 33, and 41, respectively, were rejected under 35 U.S.C. §103 as being unpatentable over Bennett as applied to claims 1, 12, 23, 33 and 41, respectively, in view of Mayeroff. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 4, 15, 26, 36 and 44, depend from claims 1, 12, 23, 33, and 41, respectively, and therefore include all the elements of claims 1, 12, 23, 33 and 41, respectively. As

discussed above with respect to claims 1, 12, 23, 33 and 41, the final Office Action failed to establish that Bennett discloses all of the recited elements. Accordingly, it is respectfully submitted that claims 4, 15, 26, 36 and 44 are not obvious.

C. The Rejection Of Claims 5, 16, 27, 37 And 42 Under 35 U.S.C. §103 As Being Unpatentable Over Bennett In View Of Bennett '178 Is Not Proper

The rejection of claims 5, 16, 27, 37 and 42 as being unpatentable over Bennett in view of U.S. Patent No. 6,261,178 to Bennett (hereinafter "Bennett '178") is not proper because the final Office Action fails to establish a *prima facie* case of obviousness.

Claims 5, 16, 27, 37 and 42, which depend from claims 1, 12, 23, 33, and 41, respectively, were rejected under 35 U.S.C. §103 as being unpatentable over Bennett as applied to claims 1, 12, 23, 33 and 41, respectively, in view of Bennett '178. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 5, 16, 27, 37 and 42, depend from claims 1, 12, 23, 33, and 41, respectively, and therefore include all the elements of claims 1, 12, 23, 33 and 41, respectively. As discussed above with respect to claims 1, 12, 23, 33 and 41, the final Office Action failed to establish that Bennett discloses all of the recited elements. Accordingly, it is respectfully submitted that claims 5, 16, 27, 37 and 42 are not obvious.

D. The Rejection Of Claims 10, 11, 21, 22, 31 And 32 Under 35 U.S.C. §103 As Being Unpatentable Over Bennett In View Of Walker et al. Is Not Proper

The rejection of claims 10, 11, 21, 22, 31 and 32 as being unpatentable over Bennett in view of U.S. Patent No. 6,001,016 to Walker et al. (hereinafter "Walker et al.") is not proper because the final Office Action fails to establish a *prima facie* case of obviousness. The following groups of claims are argued separately below: 1) Claims 10 and 11; 2) Claims 21 and 22; and 3) Claims 31 and 32.

1. Claims 10 and 11

Claims 10 and 11, which depend from claim 1, were rejected under 35 U.S.C. §103 as being unpatentable over Bennett as applied to claim 1, in view of Walker et al. To establish

prima facie obviousness, all claim elements must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 10 and 11 depend from claim 1, and therefore include all the elements of claim 1. As discussed above with respect to claim 1, the final Office Action failed to establish that Bennett discloses all of the recited elements. Accordingly, it is respectfully submitted that claims 10 and 11 are not obvious.

2. Claims 21 and 22

Claims 21 and 22, which depend from claim 12, were rejected under 35 U.S.C. §103 as being unpatentable over Bennett as applied to claim 12, in view of Walker et al. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 21 and 22 depend from claim 12, and therefore include all the elements of claim 12. As discussed above with respect to claim 12, the final Office Action failed to establish that Bennett discloses all of the recited elements. Accordingly, it is respectfully submitted that claims 21 and 22 are not obvious.

3. Claims 31 and 32

Claims 31 and 32, which depend from claim 23, were rejected under 35 U.S.C. §103 as being unpatentable over Bennett as applied to claim 23, in view of Walker et al. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 31 and 32 depend from claim 23, and therefore include all the elements of claim 23. As discussed above with respect to claim 23, the final Office Action failed to establish that Bennett discloses all of the recited elements. Accordingly, it is respectfully submitted that claims 31 and 32 are not obvious.

(VIII) CLAIMS APPENDIX

See attached Claims Appendix.

(IX) EVIDENCE APPENDIX

None.

(X) RELATED PROCEEDINGS APPENDIX

None.

CONCLUSION

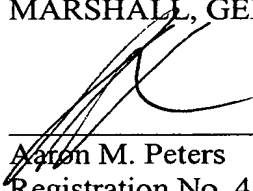
For the foregoing reasons, it is respectfully submitted that a *prima facie* case of anticipation or obviousness of the claims on appeal has not been made. Appellant therefore requests that the rejection of the claims be reversed.

Respectfully submitted,

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(VIII) CLAIMS APPENDIX

1. A gaming apparatus, comprising:
 - a display unit that is capable of generating video images;
 - a value input device;
 - a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,
 - said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,
 - said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,
 - said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,
 - said controller being programmed to cause a video image to be generated on said display unit, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo,
 - said video image comprising an image of at least five playing cards if said game comprises video poker,
 - said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,
 - said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,
 - said video image comprising an image of a bingo grid if said game comprises video bingo, and
 - said controller being programmed to determine a value payout associated with an outcome of said game.

2. A gaming apparatus as defined in claim 1, wherein said controller is programmed to allow said person a choice of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

3. A gaming apparatus as defined in claim 1, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

4. A gaming apparatus as defined in claim 1, wherein said controller is programmed to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

5. A gaming apparatus as defined in claim 1, wherein said automated selection is a random selection.

6. A gaming apparatus as defined in claim 1, wherein said automated selection is dependent upon parameters of said selected game.

7. A gaming apparatus as defined in claim 1, wherein said user-selectable options comprise the selection of one or more of said at least five playing cards to hold if said game comprises video poker, said user-selectable options comprises whether to accept another card if said game comprises video blackjack, said user-selectable options comprise a plurality of paylines if said game comprises video slots, and said user-selectable options comprise a plurality of bingo grids if said game comprises video bingo.

8. A gaming apparatus as defined in claim 1, wherein said user-selectable option comprises the option of playing one of video poker, video blackjack, video slots and video bingo.

9. A gaming apparatus as defined in claim 1, wherein said selection of a game from said group of games is performed by said controller.

10. A gaming system comprising a plurality of gaming apparatuses as defined in claim 1, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

11. A gaming system as defined in claim 10, wherein said gaming apparatuses are interconnected via the Internet.

12. A gaming apparatus, comprising:

a display unit that is capable of generating video images;

a value input device;

a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,

said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

said controller being programmed to cause a video image to be generated on said display unit, said video image representing a game other than video keno; and

said controller being programmed to determine, after said video image has been displayed, a value payout associated with an outcome of said game represented by said video image.

13. A gaming apparatus as defined in claim 12, wherein said controller is programmed to allow said person a choice of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

14. A gaming apparatus as defined in claim 12, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

15. A gaming apparatus as defined in claim 12, wherein said controller is programmed to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said game, wherein said secondary game presents a plurality of user-selectable options to said person.

16. A gaming apparatus as defined in claim 12, wherein said automated selection is a random selection.

17. A gaming apparatus as defined in claim 12, wherein said automated selection is dependent on parameters of said game.

18. A gaming apparatus as defined in claim 12, wherein said user-selectable options comprise the selection of one or more of said at least five playing cards to hold if said game comprises video poker, said user-selectable options comprises whether to accept another card if said game comprises video blackjack, said user-selectable options comprise a plurality of paylines if said game comprises video slots, and said user-selectable options comprise a plurality of bingo grids if said game comprises video bingo.

19. A gaming apparatus as defined in claim 12, wherein said user-selectable option comprises the option of playing one of video poker, video blackjack, video slots and video bingo.

20. A gaming apparatus as defined in claim 12, wherein said selection of a game from said plurality of games is performed by said controller.

21. A gaming system, comprising a plurality of gaming apparatuses as defined in claim 12, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

22. A gaming system as defined in claim 21, wherein said gaming apparatuses are interconnected via the Internet.

23. A gaming apparatus, comprising:

a display unit that is capable of generating video images;

a value input device;

a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,

said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,

said controller being programmed to allow a person to make a payline selection,

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

said controller being programmed to cause a video image to be generated on said display unit, said video image comprising a plurality of simulated slot machine reels of a slots game, each of said slot machine reels having a plurality of slot machine symbols, and

said controller being programmed to determine a value payout associated with an outcome of said slots game, said controller being programmed to determine said value payout based on at least one of a configuration of said slot machine symbols and display of a particular slot machine symbol.

24. A gaming apparatus as defined in claim 23, wherein said controller is programmed to allow said person an option of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

25. A gaming apparatus as defined in claim 23, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

26. A gaming apparatus as defined in claim 23, wherein said controller is programmed to generate a second video image on said display unit, said second video image representing a secondary game associated with said slots game, wherein said secondary game presents a plurality of user-selectable options to said person.

27. A gaming apparatus as defined in claim 23, wherein said automated selection is a random selection.

28. A gaming apparatus as defined in claim 23, wherein said automated selection is dependent on parameters of said slots game.

29. A gaming apparatus as defined in claim 23, wherein said user-selectable options comprise a number of said paylines.

30. A gaming apparatus as defined in claim 23, wherein said user-selectable options comprise said slot machine symbols.

31. A gaming system comprising a plurality of gaming apparatuses as defined in claim 23, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

32. A gaming system as defined in claim 31, wherein said gaming apparatuses are interconnected via the Internet.

33. A gaming method comprising:

causing a video image to be generated, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo,

said video image comprising an image of at least five playing cards if said game comprises video poker,

said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,

said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,

said video image comprising an image of a bingo grid if said game comprises video bingo;

allowing a person to make a wager on an occurrence of a wagering game,

receiving data relating to a request from said person made during said occurrence of said wagering game to make an automated selection from among a plurality of user-selectable options presented to said person,

performing an automatic selection from among said plurality of user-selectable options in response to said request; and

determining a value payout associated with an outcome of said game.

34. A gaming method as defined in claim 33, comprising:

allowing said person at least the option of either performing an automatic selection from among a plurality of user-selectable options or making a selection from among said user-selectable options.

35. A gaming method as defined in claim 33, comprising:

allowing said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection.

36. A gaming method as defined in claim 33, comprising:

causing a second video image to be generated, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

37. A gaming method as defined in claim 33, comprising:

randomly selecting from among said plurality of user-selectable options presented to said person.

38. A gaming method as defined in claim 33, wherein performing an automatic selection is dependent upon parameters of said selected game.

39. A gaming apparatus as defined in claim 33, comprising:
selecting one or more of said at least five playing cards to hold if said game comprises video poker;

accepting another card if said game comprises video blackjack;

selecting one or more of said paylines if said game comprises video slots; and

selecting one or more of said bingo grids if said game comprises video bingo.

40. A gaming method as defined in claim 33, comprising selecting to play one of video poker, video blackjack, video slots and video bingo.

41. A memory having a computer program stored therein, said computer program being capable of being used in connection with a gaming apparatus, said memory comprising:

a first memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow a person to make a wager on an occurrence of a wagering game;

a second memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to cause a video image to be generated on a display unit, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots, and video bingo,

said video image comprising an image of at least five playing cards if said game comprises video poker,

said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,

said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,

said video image comprising an image of a bingo grid if said game comprises video bingo,

a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among said plurality of user-selectable options in response to said request; and

a fifth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to determine a value payout associated with an outcome of said game.

42. A memory defined in claim 41, wherein said fourth memory portion is physically configured in accordance with computer program instructions that would cause a random selection from among said plurality of user-selectable options presented to said person.

43. A memory as defined in claim 41, comprising a sixth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said gaming apparatus.

44. A memory as defined in claim 41, wherein said memory comprises a sixth portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

45. A memory as defined in claim 41, wherein said fourth memory portion is physically configured in accordance with computer program instructions that would cause the

gaming apparatus to perform an automated selection that is dependent upon parameters of said selected game.

(IX) EVIDENCE APPENDIX

None.

(X) RELATED PROCEEDINGS APPENDIX

None.